

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY DAVID BROWN,
JAMES LOUIS MCKELVEY,
MICHAEL JOSEPH O'BRIEN
and JOHN WAYNE RIMMER

Appeal No. 2004-2377
Application No. 09/201,353

ON BRIEF

Before COHEN, STAAB, and MCQUADE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jeffrey David Brown et al. appeal from the final rejection (Paper No. 28) of claims 1 and 3 through 15, all of the claims pending in the application.

THE INVENTION

The invention relates to "laminated wall structures for an exterior insulation finish system" (specification, page 1).

Representative claim 1 reads as follows:

1. A laminated wall structure, suitable for use in an exterior insulation finish system, comprising the following layers in the order provided:

Appeal No. 2004-2377
Application No. 09/201,353

i) a layer of building sheathing:
ii) a barrier layer of water resistant adhesive which substantially completely covers and adheres to said building sheathing; and
iii) a layer of thermal insulation adhered to said building sheathing by said water-resistant adhesive, wherein said barrier layer of water-resistant adhesive further comprises a water-based, water-resistant, non-cementitious adhesive having sufficient tack to rapidly secure said layer of thermal insulation to said building sheathing.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Moore et al. (Moore)	3,672,951	Jun. 27, 1972
Edgar et al. (Edgar)	5,410,852	May 02, 1995

The description of "generally available" adhesives in the paragraph bridging pages 4 and 5 of the appellants' specification (the admitted prior art)

THE REJECTIONS

Claims 1, 3 through 7 and 10 through 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moore in view of the admitted prior art.

Claims 1 and 3 through 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Edgar in view of the admitted prior art.

Attention is directed to the main and reply briefs (Paper Nos. 32 and 34) and the answer (Paper No. 33) for the respective

positions of the appellants and the examiner regarding the merits of these rejections.

DISCUSSION

Both Moore and Edgar discloses laminated exterior building wall structures.

The Moore structure is a roof 10 comprising a deck 11 of steel, cement, asbestos board, wood, glass reinforced plastics or the like, an adhesive layer 16 covering the upper face 12 of the deck, a foam insulating member 19 adhered to the upper face 18 of the adhesive layer, and a water barrier layer 22 affixed to the upper face 21 of the foam member. The adhesive "is a single layer of asphalt or mastic, or alternately is a vapor barrier membrane built up of alternating layers of asphalt or bitumen and paper" (column 2, lines 36 through 39).

The Edgar structure is an exterior insulation and finish system 14 comprising a sheathing 18, an airtight barrier 20 mounted over the sheathing, an adhesive 27 applied to the airtight barrier, a layer of insulation 28 bonded to the airtight barrier by the adhesive, and a moisture-resistant lamina consisting of a base coat 29, a fiberglass reinforcing mesh 30 and a finish coat 31 covering the exposed surface of the insulation layer. Edgar teaches (see column 4, lines 2 through 4

and 38 through 41) that the adhesive can be Sto BTS-NC, which is a polymer modified Portland cement-based coating.

In applying Moore to reject independent claims 1 and 10 and Edgar to reject independent claims 1 and 8 through 10 (see pages 4 through 6 in the answer), the examiner concedes that neither reference responds to the limitations in these claims requiring the adhesive layer to comprise a water-based, water-resistant, non-cementitious adhesive having sufficient tack to rapidly secure the layer of thermal insulation to the building sheathing. To overcome these deficiencies, the examiner relies on the appellants' admission that "[s]uch adhesives are generally available and the skilled person will know, or will readily be able to determine, which of these will be most suited for use in the present invention" (specification, page 5). According to the examiner (see pages 4 through 6 in the answer), it would have been an obvious matter of design choice in light of this admission to enhance the water-resistance of the wall structures respectively disclosed by Moore and Edgar by replacing the adhesive 16 disclosed by Moore or the adhesive 27 disclosed by Edgar with a water-based, water-resistant, non-cementitious adhesive having sufficient tack to rapidly secure the layer of thermal insulation to the building sheathing.

The mere fact that water-based, water-resistant, non-cementitious adhesives of the type recited in independent claims 1 and 8 through 10 were generally available, and thus known in the art, at the time of the invention, however, does not in and of itself afford any reasonable suggestion to substitute same for the adhesives respectively disclosed by Moore and Edgar, even when such knowledge is considered in conjunction with the stated desire in each reference to provide a structure which is resistant to water and moisture. The appellants' statement that the skilled person would know, or would readily be able to determine, which of the generally available adhesives is most suited for use in the present invention presumes knowledge of the invention which is not evidenced by the applied references. The only suggestion for replacing the adhesives respectively disclosed by Moore and Edgar with a known water-based, water-resistant, non-cementitious adhesive having sufficient tack to rapidly secure the layer of thermal insulation to the building sheathing stems from hindsight knowledge derived from the appellants' disclosure. The use of such hindsight knowledge to support an obviousness rejection is, of course, impermissible.

Appeal No. 2004-2377
Application No. 09/201,353

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 10, and dependent claims 3 through 7 and 11 through 15, as being unpatentable over Moore in view of the admitted prior art, or the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 8 through 10, and dependent claims 3 through 7 and 11 through 15, as being unpatentable over Edgar in view of the admitted prior art.

SUMMARY

The decision of the examiner to reject claims 1 and 3 through 15 is reversed.

Appeal No. 2004-2377
Application No. 09/201,353

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
)	
)	APPEALS AND
LAWRENCE J. STAAB)	
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
)	
)	
JOHN P. MCQUADE)	
Administrative Patent Judge)	

JPM/kis

Appeal No. 2004-2377
Application No. 09/201,353

WENDY A. CHOI
ROHM & HAAS COMPANY
100 INDEPENDENCE MALL WEST
PHILADELPHIA, PA 19106-2399